

Office Action Summary

Application No.

09/268,437

Applicant(s)

DING ET AL.

Examiner

Gailene R. Gabel

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Withdrawal of Finality

1. Applicant's argument, see Paper No. 21, filed 12/19/02, with respect to the rejection of claims 1-5 under 35 USC 102(e) has been fully considered and is persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection are being made.

Amendment Entry

2. Applicant's amendment and response filed 12/19/02 in Paper No. 21 and 2/27/03 in Paper No. 24 are acknowledged and have been entered. Claim 1 has been amended. Claim 10 has been cancelled. Accordingly, claims 1-5 are pending and are under examination.

Rejections Withdrawn

Claim Rejections - 35 USC § 112 / 102

3. The rejections of claim 10 are now moot in light of Applicant's cancellation of the claim.

4. In light of Applicant's argument, the rejection of claims 1-5 under 35 U.S.C. 102(e) as being anticipated by Wohlstadter et al. (US 6,066,448) is hereby, withdrawn.

New Grounds of Rejection

Claim Rejections - 35 USC § 102

Art Unit: 1641

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Henkens et al. (US 6,391,558).

Henkens et al. disclose a simultaneous electrochemical assay device (biosensor array device) comprising a cell (circuit board) for holding a sample, having a plurality of plurality of working electrodes and reference, i.e. auxiliary, electrodes. Each of the working electrodes is adjacent, i.e. attached to, an analyte binding area which has an analyte binding substrate and separate from other analyte binding areas by a distance (surface area). Analyte binding substrates (bioreporter molecules) comprise of different analyte specific proteins such as antigens, antibodies, and enzymes (reductases, peroxidases, phosphatases). See column 4, line 41 to column 6, line 38 and column 19,

Art Unit: 1641

line 58 to column 20, line 56. The plurality of working electrodes quantitatively measure enzymatic reaction product. See column 17, line 51 to column 18, line 63 and column 41, lines 31-38. The device does not include a means to mix the sample in the cell.

6. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Cozzette et al. (US 5,063,081).

Cozzette et al. disclose a simultaneous electrochemical assay device (amperometric base sensor) fabricated on a substantially planar silicon substrate comprising a unit cell for holding a sample, having a plurality of working (catalytic) electrodes with identical geometry and area, and having analyte binding areas (biolayer with an active enzyme), wherein the working electrodes quantitatively measure enzymatic reaction product. The unit cell may be repeated in a geometric array several hundred times on a single silicon wafer. Each working electrode is surrounded by an auxiliary (combined counter and reference) electrode. Each of the working electrodes are adjacent to analyte binding areas (permselective silane layer) which are localized on the electrode portions of the unit cell and separated from adjacent analyte binding areas by a distance (see column 25, line 35 to column 26, line 4). The working electrodes on analyte binding areas are overlain and aligned with analyte specific proteins such as antigens and antibodies (biolayer and bioactive molecules) (see column 31, line 21 to column 32, line 5 and columns 37-38). The device does not include a means to mix the sample in the cell.

Art Unit: 1641

7. No claims are allowed.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gail Gabel whose telephone number is (703) 305-0807. The examiner can normally be reached on Monday to Thursday from 7:00 AM to 4:30 PM. The examiner can also be reached on alternate Fridays from 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le, can be reached on (703) 308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Gail Gabel
Patent Examiner
Group 1641




CHRISTOPHER L. CHIN
PRIMARY EXAMINER
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